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Ser. No. 09/769,656

REMARKS

Reconsideration of the application as amended is respectfully requested.

Claims 1-4 and 7-10 have been amended. Claim 5 and 6 have been canceled without prejudice.

The examiner respectfully rejected Claims 1-10 under 35 U.S.C. § 112, second paragraph, for lack of an antecedent basis. Claims 1-4, and 7-10 have been amended to overcome the lack of antecedent basis.

The examiner respectfully rejected Claims 1 and 2 under 35 U.S.C. § 102(b) as being anticipated by Buckley.

Claim 1 has been amended to incorporate the limitations argued by the applicant in the previous amendment, wherein the added limitations were disclosed by the original application or inherent to the device. Specifically, the pneumatic driving tool is claimed as "said pneumatic driving tool support means comprising a U-shaped ring integral to an external portion of at least one of said sidewalls." The amended language includes the "loop shape" and attachment to an "external" part of the tool organizer. Buckley fails to disclose or claim a U-shaped ring integral to the external portion of at least one sidewall. As such, Claim 1, as amended by this response, is in a condition for allowance.

Claim 2, as dependent on thrice amended Claim 1, should also be in a condition for allowance. Claim 2 has also been amended to incorporate the limitation that the storage drawer is of a rectangular shape. Buckley fails to disclose a slidably retained and rectangular shaped

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drawer, instead discloses a pivoting and arcuate shaped tray. As such, Claim 2, as amended by this response, is in a condition for allowance.

The examiner respectfully rejected Claim 3 under 35 U.S.C. § 102(b) as being anticipated by Walker.

Claim 3 has been amended to incorporate the limitations of a lateral support plate extending horizontally from and external to the containment volume, with the lateral support plate having a plurality of support means for supporting tool. Walker fails to disclose an external lateral plate having a plurality of support means. As such, Claim 3, as amended by this response, is in a condition for allowance.

The examiner respectfully rejected Claims 3, 4, 6 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Buckley and in view of McGarrah. Claim 6 has been canceled without prejudice, with the content of Claim 6 incorporated into amended Claim 3.

Claim 3, as noted previously, has been amended to include the limitations of a lateral support plate extending horizontally from and external to the containment volume, with the lateral support plate having a plurality of support means for supporting tool. Neither Buckley nor McGarrah teach or disclose such a limitation.

Claims 4 and 10, as amended by this response and dependent on Claim 3, are also in a condition for allowance.

The examiner respectfully rejected Claims 5 and 7-9 under 35 U.S.C. § 103(a) as being unpatentable over Buckley and in view of McGarrah and in further view of Hall. Claim 5 has

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been canceled without prejudice.

The differences between Buckley and McGarrah versus the present invention have been discussed above. As to Hall, discloses a plate (20) with a plurality of ringlets (26), with the plates disposed to the sides of the container. The plates are disposed to the sides because of the hindrance that would be caused by a plate aligned along the front face when using a ladder. Thus, Hall teaches away from the lateral support plate disposed along the front face as disclosed and claimed by the present invention, therefore the combination of Buckley, McGarrah and Hall do not render Claims 7-9 obvious. Therefore, Claims 7-9, as amended by this response, are in a condition for allowance.

Therefore, Claims 1-4 and 7-10, as amended, are in a condition for allowance. A Notice of Allowance is respectfully requested at the earliest possible date.

For purposes of clarification, applicant wishes to clarify the limitations of all the present claims as restricted by the *preamble*, i.e. the present invention is a TOOL ORGANIZER for use with a VEHICLE LIFT RACK. The examiner points out that "patentability is based upon the specific structure of the device, not how one intends to use it." Page 7, lines 17-18. As such, the preamble limitations are "necessary to give meaning to the claim and properly define the invention." Perkin-Elmer Corp. v. Computervision Corp., 221 USPQ 669, 675-76 (Fed. Cir.), cert. denied, 469 U.S. 857 (1984)

No litmus test can be given with respect to when the introductory words of a claim, the preamble, constitute a statement of purpose for a device or are, in themselves, additional

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structural limitations of a claim. To say that a preamble is a limitation if it gives "meaning to the claim" may merely state the problem rather than lead one to the answer. The effect preamble language should be given can be resolved only on review of the entirety of the patent to gain an understanding of what the inventors actually invented and intended to encompass by the claim.

Corning Glass Works v. Sumitomo Electric U.S.A. Inc., 9 USPQ 2d 1962, 1966 (Fed. Cir. 1989)

Applicant contend that this preamble gives "life and meaning" to the claims, serving to define the interrelationship of the mechanical elements recited in the body of the claims.

In re Wertheim, 191 USPQ 90, 102 (C.C.P.A. 1976) The fact that the examiner is unable to find meaning in the claims without this clarification is proof of this.

The specification of the patent application makes clear that the applicant was working on the particular problem of holding, storing, retaining, and organizing tools while underneath a vehicle that is raised on a lift rack. To construe the claim as covering every device having loose parts inside that rattle when manually displaced "would be divorced from reality." . In re Gold, Civ. App. No. 94-1038, slip op. at 7 (Fed. Cir. May 31, 1994) (unpublished) Thus, the preamble language does give "life and meaning," and thereby provides further limitations that must be disclosed in the prior art for the claims to be anticipated..

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103, in addition to any other art, relevant or not, is also inappropriate. However, applicant wishes to

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reiterate that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103, the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp. v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a rack mounted tool organizer having a pair of attachment means for gravity impingement on a vehicle rack, a hinged lid, a storage container, a lateral plate with a plurality of support means and a U-shaped pneumatic support means integral to a sidewall.

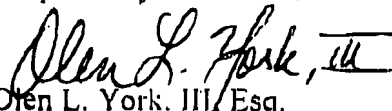
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Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ 2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Respectfully submitted,


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims

Claims 1-4 and 7-10. Claim 5 and 6 is canceled without prejudice.

Please amend the following claims by deleting the language with a strike-through
"patent" and inscribing the language which is underlined "patent."

1. (Thrice Amended) A vehicle lift rack mounted tool organizer adapted for use with a vehicle lift rack having rack arms, said organizer comprising:

a plurality of vertical sidewalls perpendicularly depending from a bottom and having an articulated lid in which said sidewalls, said bottom and said lid form a storage volume;

an adjustable attachment means depending from said storage volume connected to said storage volume for grasping the rack arm in a manner that allows said organizer to be supported through gravity impingement extending cantilever outward from said ~~support~~ attachment means in a manner that hangs below a horizontal level of the said rack arm;

a pneumatic driving tool support means for supporting pneumatic driving tools, said pneumatic driving tool support means comprising a U-shaped ring integral to an external portion of at least one of said sidewalls;

a tool support means for supporting tools formed ~~by~~ ⁱⁿ a lateral support plate, ^{extending from one sidewall} said tool support means comprising a circular opening;

a cup support means for supporting cups, said cup support means comprising a circular

✓ 112, 2nd
cat. of ele.

↑
112, 1st N.M.

??
Not what
shown in fig. 2

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opening; and

a rag support means for supporting rags, said rag support means comprising a circular

an annular element

opening.

2. (Twice Amended) The vehicle lift rack mounted tool organizer of Claim 1, further comprising a slidably retained ^{112, 15st} and rectangular shaped storage drawer provided along a lower surface of said organizer, thereby allowing for additional storage.

3. (Thrice Amended) A vehicle lift rack mounted tool organizer comprising:

an adjustable attachment means for mounting said organizer to support arms of a vehicle lift rack; ~~and~~

a main containment volume formed ~~formed~~ by a plurality of vertical sidewalls perpendicularly depending from a bottom and having an articulated lid, and extending cantilever outward from said ~~support attachment~~ means in a manner that hangs below the horizontal level of said ~~the~~ rack arm;

a hinged, lockable lid affixed to and covering said main containment volume; and

a lateral support plate, said lateral support plate extending horizontally from and externally to said containment volume, said support plate comprising a plurality of support means along a face of said organizer, said plurality of support means for housing and storing tools.

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4. (Amended) The vehicle lift rack mounted tool organizer of Claim 3, wherein said adjustable attachment means comprises a pair of support hooks for grasping ~~the~~ said rack arm in a manner that allows ~~the~~ said containment volume to be supported through gravity impingement, without the necessity for permanent fasteners.

5. Canceled.

6. Canceled.

7. (Amended) The vehicle lift rack mounted tool organizer of Claim ~~4~~ 6, wherein ~~said lateral support plate~~ further includes a pneumatic driving tool support means for supporting pneumatic driving tools, said pneumatic driving tool support means comprising a U-shaped ring integral to an external portion of at least one of said sidewalls.

8. (Amended) The vehicle lift rack mounted tool organizer of Claim ~~6~~ 4, wherein said lateral support plate further includes a tool support means for supporting tools comprising various sized orifices formed by said lateral support plate.

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9. (Amended) The vehicle lift rack mounted tool organizer of Claim 6 4, wherein said lateral support plate further includes a beverage receptacle support means for supporting a beverage.

10.(Amended) The vehicle lift rack mounted tool organizer of Claim 4, further comprising a slidably retained and rectangular shaped storage drawer provided along a lower surface of said containment volume, thereby allowing for additional storage.